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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. 727

AIR PRODUCTS, INC.,
Petitioner,

vs.

BOSTON METALS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

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IN THE

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OCTOBER TERM, 1951

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AIR PRODUCTS, INC.,
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vs.

BOSTON METALS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Air Products, Incorporated, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above-entitled case.

A certified transcript of the record, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

OPINIONS BELOW

The opinion of the District Court for the District of Maryland holding method claims 11, 13 and 19 of Anderson Patent 2,480,093 valid and infringed (R. I, 80) is reported at 98 Fed. Supp. 719. The opinion of the Court of Appeals for the Fourth Circuit dated January 4, 1952 reversing the District Court and holding the claims in suit invalid (R. III, 39) is reported at 193 F. (2d) 535. Rehearing was denied by the Court of Appeals on March 10, 1952 (R. III, 61).

JURISDICTION

The jurisdiction of the Court is invoked under Section 240(a) of the judicial code as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Sect. 1454 (1)) and under Section 5 (b, 1) of Rule 38 of this Court.

The pertinent patent statute is 35 U. S. C. 31; R. S. 4886, set forth in Part I of Appendix hereto.

QUESTIONS PRESENTED

The judgment of the Court of Appeals for the Fourth Circuit raises the following questions of law:

Question 1 — Is the doctrine of *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 to the effect that,

> ". . . a process patent can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process *might* have been performed."

still law and applicable to process claims defining a combination of process steps yielding a new coaction and an advantageous, novel result not previously known to the art?

Question 2 — Does the doctrine of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 require a holding of noninvention with respect to method claims defining a combination of method steps in a relationship yielding a new coaction and producing a new result not previously known to the art where the elements of the apparatus employed in practicing the method are admittedly old?

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals erred:

1. In holding the method claims in suit invalid on the basis of prior art which, while lacking a teaching of the claimed method, discloses apparatus which *might*, by *modification*, be employed for carrying out the novel and efficacious claimed method.

2. In failing to apply and follow the rule as to the patentability of method claims laid down by this Court in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 and in failing to find that the Anderson method fully meets the test of invention laid down in this Court's decision in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

3. In reversing the judgment of the District Court.

REASONS FOR THE ALLOWANCE OF THE WRIT

1. The opinion of the Court of Appeals failed to apply the controlling decisions of this Court and, more specifically, the decision in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403.

2. The opinion of the Court of Appeals misconstrued and misapplied the decision of this Court in *Great Atlantic &*

Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147.

3. The judgment of the Court of Appeals should be reviewed to the extent that it places reliance upon the decision of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 which is ripe for review and clarification by this Court.

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BRIEF IN SUPPORT OF PETITION

Suit was brought by petitioner against respondent for infringement of Anderson U. S. Patent No. 2,480,093 issued August 23, 1949. At the trial suit was restricted to claims 11, 13 and 19 of the patent addressed to a method for producing oxygen from atmospheric air. Before the Court of Appeals infringement was conceded. The sole question is the validity of method claims 11, 13 and 19 of the Anderson patent.

Atmospheric air, after liquefaction, may be fractionally distilled at low temperatures. Its oxygen content boils at 183° below zero Centigrade and its nitrogen content at about 196° below zero Centigrade at atmospheric pressure. As to the method claims in suit, the significant object of the Anderson invention is:

> ". . . to provide a method and means for pumping liquefied oxygen directly from a pool of commercially pure oxygen in a fractionating tower to cylinders or pipe lines in which gaseous oxygen is transported under high pressure, thereby avoiding the requirement for an oxygen storage tank and a gaseous oxygen compressing system" (R. I., 115).

The Court Below Concedes That Anderson Achieved His Objective by a Method Never in the Form Employed by Anderson Theretofore Used.

Of the Anderson contribution the Court of Appeals said:

> "To sum up, . . . it appears that Anderson was the first person to produce high pressure oxygen gas and deliver it to receptacles in one process without the use of an intermediate receptacle between the fractionating column and the ultimate containers; that this was accomplished by a method never in the precise form employed by Anderson theretofore used, viz., pumping liquid oxygen which had been withdrawn from the

fractionating column to a high pressure and avoiding vapor lock in the pump by sub-cooling the oxygen and the pump by the use of nitrogen gas from the top of the fractionating column; and that this process entered into immediate use and achieved commercial success" (R. III, 46).

Anderson conceived and produced a new relationship and a new coaction of process steps by which a novel, double use of that refrigerating value in the gaseous nitrogen from the air fractionating column employed to subcool liquid oxygen is made; (1) a first use in cooling the liquid oxygen to permit it to be pumped to high pressure and, (2) a second use of the same cold by using the subcooled oxygen to cool the infed air.

The novel, double use of the same refrigerating value in the nitrogen gas from the air fractionating column had never been disclosed or suggested prior to Anderson.

The Claimed Method of Anderson is Not Taught by the Prior Art.

The method claims were held invalid by the Court of Appeals over prior art which at best discloses apparatus which might be modified so as to permit the practice of the Anderson method but which does not teach that method.

As to the German Polard Patent 495,795, the District Court found that:

"... Polard in no sense discloses the cooling method of Anderson because the pumping and cooling of the liquid oxygen in Polard is no way connected with the column operation or caused by any column product. Like Hansen, it is a wasteful and therefore not a practical method for pumping liquid oxygen from a rectifying column, ..." (R. I, 91).

The District Court found that:

> ". . . Eichelman does not disclose the method and apparatus of Anderson any more than does Von Recklinghausen" (R. I, 89).

The Von Recklinghausen patent was abandoned by respondent as a defensive item before the Court of Appeals.

As to the Hansen patent 2,292,375, the District Court found:

> "This system . . . is similar to that disclosed by Polard . . . It clearly is not in any sense a disclosure of Anderson's method of sub-cooling, since the cooling of the liquid oxygen is entirely divorced from a column operation, and the refrigeration latent in the gaseous nitrogen or in any other product of the column is not used" (R. I, 90).

As to the German Messer and Grassmann Patent 712,480, the District Court found:

> ". . . there is no disclosure in this German patent of either of the two steps taught by Anderson to avoid vapor-lock in pumping directly from the pool in the fractionating columns without the interposition of a storage vessel" (R. I, 91).

Additionally, the District Court said of this patent:

> "The weight of the more credible testimony with respect to this Messer and Grassmann patent confirms, as the Court believes, witness Twomey's interpretation of it to the effect that the pump referred to being a suction pump, the purpose of it is to exhaust, by suction, the gas out of the receiving container, thereby syphoning the liquid oxygen from the storage container — in other words, a pumping process entirely different from the process employed by Anderson with respect to the liquid oxygen" (R. I, 92).

The District Court said, inter alia:

> "The act of invention consists in discovering how certain natural laws, as in this case, the laws of chemistry and physics, may be applied for a beneficial purpose. 'It is the result of an inventive act, the birth of an idea and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form.' *United States v. Dubillier Condenser Corp.*, 289 U. S. 178, 188. While the Supreme Court very recently in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147, has announced that the lower Courts have been too prone to adopt a standard of invention in certain types of cases involving combinations of elements that is not sufficiently exacting, we believe that the conclusion which we here reach with respect to the Anderson patent is entirely consistent with that decision" (R. I, 95).

The District Court held the method claims in suit valid, which holding is in strict conformity with the doctrine of the *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 decision of this Court and consistent with the application of that doctrine in such cases as *Karl Kiefer Mach. Co. v. U. S. Bottlers Mach. Co.*, C. A. 7, 114 Fed. (2d) 169.

The Court of Appeals Failed to Apply the Controlling Decision of this Court.

The Court of Appeals refused to follow the doctrine laid down in the *Carnegie Steel Co. v. Cambria Iron Co. supra* decision and, despite the affirmative findings of fact of the District Court and its rulings consistent with the applicable tests of invention laid down by this Court, reversed the District Court on the issue of invention holding, inter alia, that:

"Quite germane here is the opinion of Mr. Justice Jackson in the very important case of *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation*, 340 U. S. 147."

The Court of Appeals fell into clear error in failing to apply to the facts of this case the doctrine laid down by this Court in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 and in misinterpreting and misapplying the decision of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 and decisions of inferior courts to the same effect.

The decision of this Court in the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, case has figured in the disposition of a very large number of patent cases[1] and much confusion now exists in the construction and manner of application of the decision of this Court in that case which, in the public interest, is ripe for review and clarification.

CONCLUSION

For the foregoing reasons petitioner prays that its petition for writ of certiorari be granted.

Respectfully submitted,

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[1] Citations enumerated infra Appendix Part II. pp. 11-13.